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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,133	01/19/2001	Jonathan E. Lowthert	BKA.0011US	9485

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EXAMINER	
RAMAN, USHA	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/766,133	LOWTHERT ET AL.	
	Examiner	Art Unit	
	USHA RAMAN	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed December 3rd, 2007 have been fully considered but they are not persuasive.

Applicant argues that, "in Knepper there are discrete files and the advertisements are simply put between the discrete files" and that "no advertisement is inserted within any discrete media or content file". The examiner respectfully disagrees. Knepper discloses that the instruction set may indicate which advertisements to *insert into* the entertainment media file at run time. See [0041]. As such Knepper provides support for the scenario wherein an advertisement is inserted within any discrete media content file. Additionally, the claimed limitation of "contiguous block of a content data stream" broadly reads on Knepper's single show or episode. Even when a single show comprises a plurality of clips, the plurality of clips form single, continuous show (i.e. contiguous block of content data stream) similar to a television show interspersed with advertisements. See [0041]. Furthermore, Knepper also discloses the step of downloading the entire episode (i.e. receiving the contiguous block of a content data stream) prior to indicating availability of playback to the user (see [0087]), wherein the advertisements are inserted within single contiguous block (i.e. the entire episode) thereby interrupting the play of the episode and resuming the play of the episode upon the completion of the ad. For the reasons stated above, the rejection is maintained.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 27 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 09/561143 in view of Knepper.

   Claim 20 of the '143 application recites a system comprising a receiver to receive content and an advertisement; a cache coupled to the receiver to store the content and advertisement and an interface in the receiver to find a place to insert the advertisement into the content in the cache. The system of claim 20 of the '143 application differs from claim 27 of the instant application in that: it lacks an information segment having at least one ad entry having a field in the form of an interruption point specifier to indicate a point within content to interrupt the play of

content for ad insertion, prior to the resumption of the play content data stream; lacks a plurality of advertisements; fails to identify an insertion location while the content is still stored in cache and fails to recite receiving a "contiguous block of a content data stream". In an analogous art, Knepper discloses the steps of downloading a plurality of advertisements, thereby enabling selection of one of plurality of available advertisements for playback with content in accordance with content and ad compatibility, and downloading an instruction set (info segment) customized for the content having at least one ad entry in the form of an interruption point specifier indicating the point within content to interrupt the play of show to insert the ad (see [0052]), wherein the insertion location is identified by the receiver while the content is still stored in cache. Knepper also discloses that the instruction set may indicate which advertisements to insert into the entertainment media file at run time. See [0041]. Therefore it would have been obvious to modify claim 20 of the '143 application in view of Knepper's teachings by providing a plurality of advertisements cached at the receiver and an instruction set indicating insertion points and other rules for insertion of plurality of advertisements into the content that enables customized insertion of ads, to produce a customized lineup of advertisements in a content show. The instruction set of the modified system is advantageous in that it can be altered over time thereby targeting ads that are pertinent to the content as well as the user's tastes.

4. Claim 27 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of copending Application No. 09/561143 in view of Knepper.

Claim 37 of the '143 application recites a system comprising a receiver to receive content and an advertisement; a cache coupled to the receiver to store the content and advertisement and an interface in the receiver to find a place to insert the advertisement into the content in the cache. The system of claim 37 differs from claim 27 of the instant application in that: it lacks an information segment having at least one ad entry having a field in the form of an interruption point specifier to indicate a point within content to interrupt the play of content for ad insertion, prior to the resumption of the play content data stream; lacks a plurality of advertisements and fails to recite receiving a "contiguous block of a content data stream". Knepper discloses the steps of downloading a plurality of advertisements, thereby enabling selection of one of plurality of available advertisements for playback with content in accordance with content and ad compatibility, and downloading an instruction set (info segment) customized for the content having at least one ad entry in the form of an interruption point specifier indicating the point within content to interrupt the play of show to insert the ad (see [0052]). Knepper also discloses that the instruction set may indicate which advertisements to insert into the entertainment media file at run time. See [0041]. Therefore it would have been obvious to modify claim 37 of the '143 application in view of Knepper's teachings by providing a plurality of advertisements cached at the receiver and an instruction set indicating insertion

points and other rules for insertion of plurality of advertisements into the content that enables customized insertion of ads, to produce a customized lineup of advertisements in a content show. The instruction set of the modified system is advantageous in that it can be altered over time thereby targeting ads that are pertinent to the content as well as the user's tastes.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 27-30, 34-35, and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Knepper et al. (US PG Pub. 2001/0042249).

With regards to claim 27, Knepper discloses a receiver (client receiver) to receive content (media files) with an information segment (instruction set) and a plurality of advertisements files (see [0008], [0009], the information segment having at least one ad *entry* (<ADInsert>.....</ADInsert>, note that the entry itself is an item entered in a list]), the ad entry having a field (<ADInsert>) in the form of an interruption point specifier to indicate a point to insert an advertisement in the

content (interruption point at a location is indicated by placement of the <ADInsert> tag in the instruction set, see [0052]. Claim 27 additionally recites the step of receiving "a contiguous block of a content data stream", wherein the interruption point specifier indicates a point within the contiguous block of content data stream to interrupt the play of the content data stream and to insert an advertisement in the content data stream. Knepper discloses that the instruction set may indicate which advertisements to *insert into* the entertainment media file at run time. See [0041]. Furthermore, even in the scenario wherein a show may comprise plurality of clips, the plurality of clips form a single continuous show (i.e. a contiguous block of content data stream) similar to a television show interspersed with advertisements. See [0041]. Knepper additionally discloses the step of downloading the entire episode (i.e. receiving the contiguous block of content data stream) prior to indicating availability of playback to the user (see [0087]), wherein the advertisements are inserted within single contiguous block (i.e. the entire episode) thereby interrupting the play of the episode and resuming the play of the episode upon the completion of the ad.

A cache (client side storage), coupled to said receiver to store the content with information segment and the plurality of advertisements (see [0008], [0009], [0014], advertisements, media files, and information segment are downloaded and pre-cached at client side);

An interface (client side application software) in the receiver identifies a content location (location identified via placement of ADInsert tags relative to media

clip entries) and an advertisement (see [0081]-[0083]), out of the plurality of advertisements, to insert in the location; the interface (client side application) to identify based on data from the interruption point specifier the location while the content is still stored in cache (i.e. content is still stored in cache during playback of media files as well as advertisements).

With regards to claim 28, Knepper discloses that a plurality of shows maybe requested by the viewer for subsequent viewing (see [0028]). Knepper further discloses that when each of the shows is requested, the corresponding instruction set is also delivered to the client (see [0026]). When the user finally plays one of the plurality of rested shows, the system executes the instruction set corresponding to the show requested, and therefore has means to associate an identifier of the show with its corresponding instruction set (see [0038]).

With regards to claim 29, 37 and 38, the interface in the system utilizes an *info segment* having a plurality of fields, one field comprising an interruption point specifier (ADInsert tag). It is further noted that the recited limitation of "another field selected from the group consisting of a maximum interruption length specifier, a resume indicator, a permitted ad type specifier, a prohibited ad type specifier and an ad lock", is written in the alternative language and wherein Knepper anticipates a second field comprising permitted/prohibited (positive/negative associations) ad specifier. See [0080]-[0081]. As such claims 37 and 38, are anticipated by Knepper due to the alternative claim language in claim 29.

With regards to claim 30, the ad entry includes the plurality of fields (positive/negative associations, insertion point) to control the relationship between the content and the plurality of advertisements (see [0082]).

With regards to claim 34, the instruction set lists the plurality of media and advertisement in a manner of sequential playback order. When an 'adclip1' is listed after a 'mediclip1', the 'adclip1' is to be started when 'mediaclip1' has terminated playing (and therefore mediaclip1 has no sound associated with it). Therefore in accordance with the ordering of the instruction set, the location of the 'adclip1' is after the 'mediaclip1', upon whose playback termination, the sound volume associated with the 'mediaclip1' goes to zero.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper (US PG Pub. 2001/0042249) in view of Schoff (US Pat. 6,240,555).

With regards to claims 31, Knepper does not disclose the step of further storing a electronic program guide, the program guide having a program identifier

and an associated info segment, the program guide enabling locating the info segment corresponding to the selected program.

Schoff discloses a method of associating a supplementary content with a program, wherein the program guide has a program identifier (storage pointer) and enables locating the supplemental data corresponding to a selected program. See fig. 3.

It would have been obvious to one of ordinary skill by modifying the system of Knepper in view of Schoff by using an EPG to locate the information segment associated with program identifier. The motivation is to enable the user to select a show or content for playback from an EPG and enable association of information segment for targeted advertisements.

9. Claims 32, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US PG Pub. 2001/0042249).

With regards to claim 32, Knepper discloses that the client system is a computer system. Therefore Knepper does not disclose a television receiver.

Examiner takes official notice that PCTV receiver systems were well known in the art at the time of the invention and providing the client a wider range of services.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by using a PCTV system so that the user can receiver communications from a computer network as well as a television network.

With regards to claim 35, Knepper discloses a content identifying a show (e.g. SID=48100) for identifying a particular show. See [0050]. Knepper does not disclose that the content identifier is a hashed value of a closed caption text.

Examiner takes official notice that hashing methods were well known in the art at the time of the invention for generating keys related to content information used to identify the content location.

It would have been well known to one of ordinary skill in the art at the time of the invention to modify the system by hashing value of the closed caption text of a program to generate a content identifier, so that the show can be identified based on its content. Such a content identifier can be used to set recording (in a PC/TV system) where episodes can be identified uniquely based on their content (i.e. closed caption data) thereby preventing duplicative recording.

With regards to claim 36, Knepper discloses a content identifying a show (e.g. SID=48100) for identifying a particular show. Knepper does not disclose that the content identifier is a hashed value of a closed caption text.

Examiner takes official notice that VCR+ codes were well known in the art at the time of the invention for used to identify programs to record.

It would have been well known to one of ordinary skill in the art at the time of the invention to modify the system by using a VCR+ code as a content identifier, so that the recording of the show identified according to the VCR+ codes can be recorded.

10. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US PG Pub. 2001/0042249) in view of Yiu (US Pat. 6,008,777).

With regard to claim 33 Knepper does not disclose connecting the system to a presentation device through a wireless connection.

Yiu discloses the step of a PC (located in a den or a office) transmitting video signals to a presentation device (in a family room) over a wireless connection, so that user can view contents of PC from a remote location. See abstract.

It would have been obvious to one of ordinary skill to one of ordinary skill in the art to provide a wireless connection from a PC to a presentation device in home entertainment center, thereby enabling the PC to be located remote to the presentation device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moore et al. (US PG Pub 2001/0047298) transmitting a meta data containing content relevant information at a scene level, as well as pointers to advertisements that are relevant to the particular scene. A single show can have a plurality of scenes (similar to Knepper's "clips"), with each scene comprising its set of relevant advertisements in a meta data file.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623

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